

## REMARKS

In the first Office Action mailed June 20, 2003, Claims 1-20 were rejected under 35 USC §112, second paragraph, for indefiniteness. Page 13 of the specification has been amended in lines 14-15 to correct a readily apparent typographical error. More particularly, ~~ON/OFF CONTROL~~ has been replaced with shutter button before reference numeral 64. No new matter has been added, and this is confirmed by the reference on page 13 in line 11, as originally filed, to "shutter button 64." Claims 1, 8, 18 and 20 have been similarly amended. Accordingly, withdrawal of the rejection of Claims 1-20 under 35 USC §112, second paragraph, is requested.

New Claims 21 - 25 have been added that focus on the novel combination of features of the disclosed camera. The text of the SUMMARY OF THE INVENTION section and ABSTRACT have been amended to make them consistent with the scope of new independent Claim 21. The specification has also been amended in several locations to emphasize that Figs. 5 - 7 and the text describing the same refer to preferred embodiments of the invention, consistent with the caption on page 6, line 4 and the text at page 17, line 6, as originally filed. No new matter has been added.

In the first Office Action, Claims 1-4, 6-7, 11-14, 16 and 17 were rejected for alleged obviousness over Kato in view of Parulski et al. The examiner admitted that Kato does not teach selectively generating a first sequence of high resolution still image files or a second sequence of low resolution still image files. However, the examiner alleges that it would have been obvious to "combine the camera taught by Kato with the generation of low and high resolution images taught by Parulski et al. to make a camera with the limitations of Kato that generates high resolution images for still images and low resolution images to later be used as motion images." The examiner alleges that one of ordinary skill "would have been motivated to make such a modification to obtain still images of high quality and motion images with less data such that it is possible to capture the motion images at an adequate frame rate."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). In rejecting Claims 1-4, 6, 7, 11-14, 16 and 17 under 35 U.S.C. §103(a) over Kato combined with Parulski et al., the Examiner has not met the three requirements recited in *In re Vaeck*.

There is no express suggestion in either Kato or Parulski et al. to combine the references as proposed by the examiner. Kato is concerned with the ability to selectively record a single high resolution frame in a motion video sequence as a still picture. Parulski et al. is no more pertinent to Applicant's claimed invention than the prior art illustrated in Figs. 3 and 4 of the above-captioned application and described on page 3, lines 16-20 thereof. In other words, the camera has a parallel hardware architecture that offers two alternative paths for recording still and motion image sequences. The inter-frame and intra-frame coding of Kato is so complex that a modification thereof that would somehow provide a motion video sequence made up of low resolution image files using the different coding techniques of Parulski et al. would not have had a reasonable chance of success. Furthermore, even if Kato and Parulski et al. were combined in the manner proposed by the examiner, the end result would still not be the invention of independent Claims 1, 11, 20 and 21 which all require *firmware* conversion of the sequence of low resolution of still image files into a motion video sequence.

Accordingly, withdrawal of the obviousness rejection of Claims 1-4, 6-7, 11-14, 16 and 17 for alleged obviousness over Kato in view of Parulski et al. is requested. The rejections of the remaining pending claims are similarly based on the combination of Kato and Parulski et al., along with other references and are improper for the reasons already stated. Accordingly, withdrawal of the obviousness rejections of Claims 5, 8, 9, 10, 15, 18, 19, and 20 is also requested.

Attached herewith as Attachment 1 is a replacement sheet for the Abstract.

This application is in condition for allowance. Authorization is given to charge Deposit Account No. 08-2025 for the additional fee required for new Claims 21-25.

Respectfully submitted,

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**DIGITAL STILL CAMERA WITH STILL AND MOTION IMAGE CAPABILITIES**

**ABSTRACT OF THE DISCLOSURE**

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A camera has an image sensor mounted in a housing for receiving light and generating output signals representative of an image. A circuit processes the output signals in response to actuation of a shutter button mounted in the housing. A control circuit is connected to the processing circuit for selectively generating a first sequence of high resolution still image files or a second sequence of low resolution still image files and for executing firmware to convert the second sequence into a motion video sequence.

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